

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Hugh B. Morrison et al.
Serial Number: 09/868,426
Atty. Dkt: RCA 89,186
Filing Date: June 15, 2001
For: METHOD FOR OPERATING A VIDEO PROCESSING
APPARATUS VIA AN ELECTRONIC MAIL MESSAGE
Art Unit: 2421
Examiner: Dominic D. Saltarelli

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

In response to the Examiner's Answer dated August 17, 2009, Appellants hereby submit a Reply Brief in accordance with 37 C.F.R. §41.41 for the above-referenced application.

Response to Examiner's Answer

In response to the Examiner's Answer dated August 17, 2009, Appellants maintain that claims 10-29 are patentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,374,406 issued to Hirata (hereinafter, "Hirata") in view of WO 99/35847 (hereinafter, "Westlake"), and further in view of U.S. Patent No. 5,375,235 issued to Berry et al. (hereinafter, "Berry").

First, Appellants again note that independent claim 10 recites:

"receiving an electronic mail message remotely from a user, said electronic mail message comprising an operating command and program identification information including at least one of a first type of program identification information and a second type of program identification information;

processing said electronic mail message to determine whether said electronic mail message includes said first type of program identification information;

scheduling an event responsive to said operating command for a program identified by said program identification information without searching program guide information for said program if said electronic mail message includes said first type of program identification information;

continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information;

searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information and does not include said first type of program identification information;
and

scheduling said event responsive to said operating command if said program is found during said searching step." (emphasis added)

As indicated above, independent claim 10 defines a method for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that includes an operating command and at least one of two different types of program identification information (e.g., channel/time information and/or a program name). The received electronic mail message is processed to determine whether it includes the first type of program identification information. An event is scheduled responsive to the operating command for a program identified by the program identification information

without searching program guide information for the program if the electronic mail message includes the first type of program identification information.

Also according to the method, the electronic mail message continues to be processed to determine whether it includes the second type of program identification information only if the electronic mail message does not include the first type of program identification information. The program guide information is then searched for the program using the program identification information only if the electronic mail message includes the second type of program identification information and does not include the first type of program identification information. An event is scheduled responsive to the operating command if the program is found during the search of the program guide information. Independent claims 17 and 24 define subject matter similar to independent claim 1, but are written in “apparatus” format.

In the aforementioned manner, the claimed invention defines a method and apparatus for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name).

A. The Proposed Combination Of References Fails To Teach Or Suggest All Elements Of The Claimed Invention

Appellants maintain that neither Hirata, Westlake nor Berry, whether taken individually or in combination, discloses or suggests all of the foregoing elements of independent claims 10, 17 and 24 (and their respective dependent claims).

On pages 8-10 of the Examiner’s Answer dated August 17, 2009, the Examiner now ostensibly alleges that Berry discloses both the claimed “continuing to process said electronic mail message...” and the claimed “searching said program guide information...” elements of independent claims 10, 17 and 24 referenced above (ostensibly admitting that Hirata and Westlake both fail to disclose such elements).

Appellants respectfully disagree with the Examiner's foregoing allegations. Even assuming, *arguendo*, that Berry discloses the claimed "continuing to process said electronic mail message..." element, the reference clearly fails to disclose or suggest, *inter alia*, the claimed "searching said program guide information..." element. In particular, on pages 5-6 of the final Office Action dated December 18, 2008, the Examiner alleges:

"... Berry teaches performing a searching operation, where a search is first performed on a first type of information, and only broadens the search for a second type of information if a match is not found in the first search, providing the benefit of improved speed by avoiding unnecessary searching (wherein a first type of words are highly specific and are located quickly, whereas a second type of words are less specific and require more processor intensive searching, therefore the type 1 words are given priority, and additional searching is done if a type 1 word is not found." (emphasis added; citing column 4, lines 3-9 and column 5, line 36 to column 6, line 19)

As alleged above by the Examiner, "Berry teaches performing a searching operation, where a search is first performed on a first type of information, and only broadens the search for a second type of information if a match is not found in the first search" (emphasis added). This latter (broadened) search of Berry allegedly corresponds to the claimed element of "continuing to process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information" (emphasis added).

However, even assuming, *arguendo*, that the above-referenced teaching of Berry does properly correspond to the claimed "continuing to process said electronic mail message..." element, the reference clearly fails to disclose or suggest, *inter alia*, the next claimed element of "searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information ..." (emphasis added).

That is, according to the claimed invention, there are at least three different search inquiries performed. First, the electronic mail message is processed to determine whether it includes the first type of program identification information (i.e., the claimed “processing said electronic mail message...” element). Secondly, if the electronic mail message does not include the first type of program identification information, the message continues to be processed to determine if it includes the second type of program identification information (i.e., the claimed “continuing to process said electronic mail message...” element). Thirdly, if the electronic mail message includes the second type of program identification information, the program guide information is then searched for the program (i.e., the claimed “searching said program guide information...” element). In other words, the claimed invention provides that the first two search inquiries are performed upon a first data item (i.e., the electronic mail message), and the third search inquiry is performed upon a second and different data item (i.e., the program guide information).

As alleged by the Examiner, “Berry teaches performing a searching operation, where a search is first performed on a first type of information, and only broadens the search for a second type of information if a match is not found in the first search” (emphasis added). However, after Berry “broadens the search” (i.e., wherein such broadened search presumably corresponds to the claimed “continuing to process said electronic mail message...” element), it does not then subsequently search another (different) data item (i.e., program guide information) only if the broadened search identifies a certain type of information. As such, Berry (like Hirata and Westlake) clearly fails to disclose or suggest, *inter alia*, the claimed element of “searching said program guide information for said program using said program identification information only if said electronic mail message includes said second type of program identification information ...” (emphasis added).

Accordingly, for at least the foregoing reasons, Appellants maintain that neither Hirata, Westlake nor Berry, whether taken individually or in combination, discloses or suggests all of the elements of independent claims 10, 17 and 24 (and their respective dependent claims).

B. There Is No “Apparent Reason” To Combine The References In The Proposed Manner

In Appellants’ previously submitted Appeal Brief, it was argued that there is no “apparent reason” that one of ordinary skill in the art would combine the teachings of Berry to the combination of Hirata and Westlake, as proposed (see *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007)). In particular, combining the teachings of Berry to the combination of Hirata and Westlake, as proposed, would defeat one of the primary objectives of Westlake, namely the ability to distinguish those terms in an electronic message which have a match in the program information of an electronic program guide (EPG) from terms which have no such match (see, for example, the Abstract of Westlake).

On pages 10-11 of the Examiner’s Answer dated August 17, 2009, the Examiner responds to the foregoing argument by alleging:

“In response, it is unclear how the appellant arrived at the conclusion that any kind of modification would be done to Westlake’s searching algorithm when the combination of Hirata and Westlake is modified in view of Berry... The modification made in view of Berry to the Hirata and Westlake combination is the circumstances under which each of these distinct searching algorithms takes place (namely, Hirata’s search is performed first, and if no control commands are found, then Westlake’s broader searching algorithm is performed), since Berry expressly teaches the benefit of performing a narrow search using specific predefined terms before even trying to search using a broader set” (emphasis added)

In response to the foregoing argument, Appellants maintain that the Examiner’s proposed modification to the Hirata/Westlake combination still defeats one of the primary objectives of Westlake, namely the ability to distinguish those terms in an electronic message which have a match in the program information of an electronic program guide (EPG) from terms which have no such match, since Westlake’s search would only be performed “if no control commands are found” in Hirata’s search.

As indicated in Appellants' Appeal Brief, Westlake teaches a method that compares all terms in a received electronic message to terms in the program information of an electronic program guide (EPG), without regard to whether certain information is included or not included in the received electronic message (see, for example, page 23, lines 14-28 and steps S1-S2 of FIG. 3). By performing the comparison in this manner, Westlake is readily able to fulfill his primary objective of distinguishing those terms in the electronic message which have a match in the program information of the electronic program guide (EPG) from terms which have no such match.

However, by modifying the combination of Hirata and Westlake using the teachings of Berry, as proposed, Westlake would "[continue to] process said electronic mail message to determine whether said electronic mail message includes said second type of program identification information only if said electronic mail message does not include said first type of program identification information" (emphasis added). By restricting his comparison method based on the content of the received electronic message in this manner, Westlake would inherently yield incomplete comparison results (e.g., no results at all), and thereby fail to achieve one of his primary objectives since he would only continue to process a received electronic message if said message did not include a certain type of information.

Accordingly, since combining the references in the proposed manner would defeat one of the primary objectives of the Hirata/Westlake combination, Appellants maintain that there is no "apparent reason" for one skilled in the art to combine the references in the proposed manner (again, see *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007)).

C. The Berry Reference Constitutes "Non-Analogous Art" Under Federal Circuit Law

In Appellants' previously submitted Appeal Brief, it was argued that the Berry reference constitutes "non-analogous art" under the law of the Federal Circuit, and

therefore has no legal bearing on the determination of obviousness under 35 U.S.C. §103 in this case.

On page 11 of the Examiner's Answer dated August 17, 2009, the Examiner responds to this argument by alleging:

"In response, the examiner must disagree, given that the particular problem with which the inventor was involved was a matter of implementing a searching algorithm that parses an electronic message and searches a memory for corresponding terms ..." (emphasis added)

In response, Appellants respectfully disagree with the Examiner's characterization of the particular problem with which the inventor was involved. In particular, Appellants submit that the particular problem with which the inventor was involved was to provide a method and apparatus for scheduling an event (e.g., program recording, etc.) responsive to a received electronic mail message that advantageously provides enhanced performance and versatility by being able to schedule the event in response to at least two different types of program identification information (e.g., channel/time information and/or a program name), not to simply implement a searching algorithm that parses an electronic message and searches a memory for corresponding terms, as alleged. Accordingly, Appellants maintain that the Berry reference, which endeavors to provide a method of indexing keywords for searching in a database recorded on a CD-ROM, with the objective of improving the time requirement for accessing data (see, for example, column 1, line 7 to column 2, line 66), is not "within the field of the inventor's endeavor," and not "reasonably pertinent to the particular problem with which the inventor was involved." See, for example, *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). Accordingly, Appellants maintain that the Berry reference constitutes "non-analogous art" under the law of the Federal Circuit, and therefore has no legal bearing on the determination of obviousness under 35 U.S.C. §103 in this case.

For at least the above stated reasons, Appellants maintain that claims 10-29 are patentable under 35 U.S.C. §103(a) over the proposed combination of Hirata, Westlake

and Berry, and respectfully request the Board to reverse the rejection and pass this application to issue.

Respectfully submitted,

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